

REMARKS

Claims 1-29 are pending prior to entering this amendment.

The examiner objects to claims 16-23 as employing a phrase —adapted to— that does not distinguish over the prior art since it is not a positive limitation but only requires the ability to so perform.

The applicants amend no claims.

Claims 1-29 remain in the application after entering this amendment.

The applicants add no new matter and request reconsideration.

Claim Objections

MPEP § 2111.04 states in pertinent part.

Claim scope is not limited by claim language... that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”

Examiner Hollington first objected to claims 16-23 for using the term “capable of” that the applicant changed to —adapted to— in the immediately preceding amendment (filed June 6, 2007). Section 2111.04 raises a question as to whether the use of certain terms, including the term “adapted to,” has a limiting effect on the structure recited in the claims. But Section 2111.04 clearly instructs the examiner to analyze the specific facts of the case to determine whether the use of the term “adapted to” limits, in fact, the claims’ structure.

In *Hoffer*, cited above, the court held that a whereby clause was limiting and a condition material to patentability that could not be ignored to change the substance of the invention. In contrast, in *Minton*, also cited above, the court held that the whereby clause there simply

expressed the intended result of a step previously positively recited. In the present application, the applicants employ the term “adapted to” as a positive limitation on the specific structure recited. For example, claim 16 recites a probe head adapted to probe.... The probe, by its terms, must be adapted to probe or capable of probing. An infringing product need not be operating, i.e., probing, to infringe the claim but rather merely “capable of probing” or “adapted to probe.” Like the whereby clause in *Hoffer*, the term “adapted to” here is used as a positive limitation on the structure of the claim. Unlike the whereby clause in *Minton*, the term “adapted to” does not merely express a result of a step previously positively recited.

The applicants ask the examiner to remove the claim objection and issue the case.

In the interest of expediency, the applicants consent to an examiner’s amendment to replace the term “adapted to” with “capable of” if that would ease the examiner’s concerns.

Conclusion

For the foregoing reasons, the applicants request reconsideration and allowance of all remaining claims. The Applicants encourage the Examiner to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 32231

Respectfully submitted,

MARGER JOHNSON & MCCOLLOM P.C.

A handwritten signature in black ink, appearing to read 'Graciela G. Cowger', is written over a horizontal line.

Graciela G. Cowger
Registration No. 42,444

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
(503) 222-3613